

Serial No. 09/977,774
Amendment dated 5/6/04
Response to Office Action dated 1/6/04

Docket No. DKT 01096
(BWI-00073)

REMARKS

Claims 1-9 and 11-22 are pending.

Claims 1-9 and 11-22 stand rejected.

Claims 1 and 22 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

35 USC §103(a) REJECTION

Claims 1-9 and 11-22 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,544,540 to Holman in view of U.S. Patent No. 3,135,213 to Smith et al.

Applicant respectfully traverses the 35 USC §103(a) rejection of claims 1-9 and 11-22.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d

(BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. §112 ¶ 4.

Claim 1, as amended, recites, among other things, a pump for pumping fluid in a vehicle having at least one fluid reservoir, said pump comprising: (1) a pump housing having a pump element; (2) an electric motor operatively attached to and disposed within said pump housing; (3) a pumping chamber, the pump element operatively coupled to said electric motor, said pumping chamber including an intake port for receiving fluid from said fluid reservoir and an exit port for pumping fluid from said fluid reservoir; and (4) at least one other intake port or exit port derived from porting configured in a surface adjacent to and not formed integrally with the pump, wherein said pump is submerged within said fluid reservoir of said vehicle, wherein said fluid reservoir is selected from the group consisting of a transmission, transfer case, engine reservoir, and combinations thereof.

Claim 22, as amended, recites, among other things, a pump for pumping of fluid from at least one fluid reservoir of a vehicle, said fluid pump comprising: (1) a submerged pump housing; (2) a motor situated in said pump housing and exposed to the fluid in the fluid reservoir, said motor including a self centering armature therethrough; (3) a pump chamber at the base of said pump housing; (4) a pump element operably attached to said armature in said chamber for pumping fluid; and (5) a surface adjacent to and not formed integrally with the pump housing and operatively associated with the pump chamber for providing inlet or outlet of fluid to the pump chamber contained in the pump housing, and said surface including at least one oil fill passage connecting said fluid reservoir to said pump chamber for intake and pumping of said oil from said fluid reservoir, wherein said pump is submerged within said fluid reservoir of said vehicle, wherein said fluid reservoir is selected from the group consisting of a transmission, transfer case, oil reservoir, and combinations thereof.

Neither to Holman and/or Smith et al., either alone or in combination therewith, suggests such structures.

The Examiner correctly noted that Holman is completely silent with respect to the pump element being operatively connected to an electric motor. Furthermore, Holman is also completely silent with respect to the requirement that the electric motor be disposed within or situated in the pump housing, as presently claimed.

Smith et al. does not cure the deficiencies in the teachings of Holman. Specifically, Smith et al. specifically teaches that the pump element (including the pump housing) and

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the electric motor (including the motor housing) are separate and distinct structures. There is no disclosure in Smith et al. that the pump element and the electric motor should be contained within a single housing. Furthermore, Smith et al. teaches that the inlet aperture 56 and the outlet aperture 60 are not coplanar, but rather are perpendicular to one another. This is in contradistinction to the present invention wherein the inlet and outlet ports are substantially coplanar, i.e., that lay on the same single surface. Thus, one of ordinary skill in the art would not look to Smith et al. in order to modify the structure disclosed by Holman, as suggested by the Examiner.

Therefore, the Applicants submit that neither Holman and/or Smith et al., either alone or in combination therewith, renders claims 1 and 22 obvious. Furthermore, claims 2-9 and 11-21, which depend from and further define claim 1, are likewise allowable.

Accordingly, the Applicants submit that the 35 USC §103(a) rejection of claims 1-9 and 11-22 has been overcome.

CONCLUSION

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by Examiner in the Office Action of January 6, 2004 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

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The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

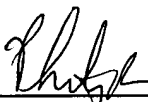
Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 501612. A duplicate copy of this letter is enclosed herewith for this purpose.

Respectfully submitted,

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